

**REMARKS**

1. Status of Claims and Formal Matters

Claims 1-39 are pending in this application. Claims 6-12 and 24-33 have been withdrawn from consideration by the Examiner. *See* Office Action Summary, Disposition of Claims. Claims 1-39 are hereby canceled without prejudice to pursuing these claims in one or more continuing applications. New claims 40-63 are added. All of the new claims are generic to the elected antibody species (6B1). Upon entry of these amendments, claims 40-63 will be pending and under active consideration. Applicant respectfully requests entry of the amendments and remarks made herein into the file history of the present application.

Support for new claim 40 may be found in claims 1, 8 and 9 as filed.

Support for new claim 41, 44, 47, 50, 53, 56 may be found in claim 2 as filed.

Support for new claim 42, 45, 48, 51, 54, 57 may be found in claim 3 as filed.

Support for new claims 43 and 52 may be found in claim 1, Figure 19 and the paragraph beginning at page 27, line 14 of the specification as filed.

Support for new claim 46 may be found in claim 13 as filed.

Support for new claim 49 may be found in claim 16 as filed.

Support for new claim 55 may be found in claim 19 as filed.

Support for new claims 58 and 63 may be found in claim 22 and the paragraph bridging pages 41 and 42 of the specification as filed.

Support for new claim 59 may be found in claim 35 and page 22, lines 10-14 of the specification as filed.

Support for new claim 60 may be found in claim 36 as filed.

Support for new claim 61 may be found in claim 37 as filed.

Support for new claim 62 may be found in claim 38 as filed.

The specification is also amended to comply with the sequence listing requirements in the paragraphs beginning at the following: page 27, line 14; page 27, line 21; last line of page 47, bridging pages 47 and 48. An amended sequence listing under 37 C.F.R. § 1.825 is also provided.

The specification is also amended to update the status of the priority documents.

No new matter has been added by the amendments.

Applicant thanks the Examiner for acknowledging, at item 14 of the Office Action, that claims drawn to specific TGF $\beta$  antibodies which recite all six CDRs are in condition for allowance.

## 2. Patentability Arguments

### a. Objections

#### i. Priority

At page 3 of the Office Action, the Examiner states that Applicant should amend the first line of the specification to update the status of priority documents. Applicant has amended the specification to update the status of the priority documents and respectfully requests withdrawal of the objection.

#### b. Claim Rejections

##### **i. The Rejections Under 35 U.S.C. § 112, First Paragraph, For Lack of Enablement Should Be Withdrawn**

At page 4 of the Office Action, the Examiner rejected claims 1-5, 13-23 and 34-39 under 35 U.S.C. § 112, first paragraph, for allegedly containing subject matter not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Applicant has canceled previous claims 1-5, 13-23 and 34-39 rendering moot any rejections thereto. New claims 40-63 all recite antibody-antigen binding domains which comprise six CDRs of defined sequence or VH and VL domains of defined sequence. One of ordinary skill in the art would expect and predict on the basis of the instant specification that antibodies and antibody fragments with these defined sequences would bind to TGF $\beta$ . One of

ordinary skill in the art would therefore be able to produce the invention commensurate with the scope of the pending claims from the instant disclosure alone and no undue experimentation would be required. Accordingly, Applicant respectfully submits that the full scope of new claims 40-63 are enabled by the specification and hereby requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph for lack of enablement.

**ii. The Rejections Under 35 U.S.C. 102(b) Should Be Withdrawn**

At page 6 of the Office Action, the Examiner rejected claims 1-5 under 35 U.S.C. § 102(b) as allegedly anticipated by Griffiths *et al.* (WO 93/11236) (hereinafter “Griffiths WO”).

Applicant has canceled claims 1-5, rendering moot any rejections thereof. Applicant respectfully submits that Griffiths WO fails to disclose the subject matter of new claims 40-63. Accordingly, new claims 40-63 are novel over Griffiths WO and the rejections under 35 § U.S.C. § 102(b) may be properly withdrawn. Applicant respectfully requests reconsideration and withdrawal of the rejection.

**iii. The Rejections Under 35 U.S.C. § 102(e) Should Be Withdrawn**

At page 6 of the Office Action, the Examiner rejected claims 1-5 under 35 U.S.C. § 102(e) as allegedly anticipated by Griffiths *et al.* (U.S. Patent No. 5,962,255) (hereinafter “Griffiths US”).

Applicant has canceled claims 1-5, rendering moot any rejections thereof. Applicant respectfully submits that Griffiths US fails to disclose the subject matter of new claims 40-63. Accordingly, new claims 40-63 are novel over Griffiths US and the rejections under 35 U.S.C. § 102(e) may be properly withdrawn. Applicant respectfully requests reconsideration and withdrawal of the rejection.

**iv. The Rejections Under 35 U.S.C. § 103(a) Should Be Withdrawn**

At page 7 of the Office Action, the Examiner rejected claims 1-5 under 35 U.S.C. § 103(a) as allegedly obvious over Lucas *et al.* (J. Immunol., 145:1415-1422, 1990) (hereinafter “Lucas”) and/or Dasch *et al.* (U.S. Patent No. 5,571,714) (hereinafter “Dasch”) and/or Iwata *et*

*al.* (U.S. Patent No. 5,262,319) (hereinafter “Iwata”) in view of Griffiths WO or Griffiths US.

Applicant has canceled claims 1-5, rendering moot any rejections thereof. Applicant respectfully submit that the cited references, either alone or in combination, do not disclose the subject matter of new claims 40-63. Accordingly, new claims 40-63 are nonobvious over the cited references and the rejection under 35 U.S.C. § 103(a) may be properly withdrawn. Applicant respectfully requests reconsideration and withdrawal of the rejection.

**v. The Rejections For Non-Statutory Double Patenting Should Be Withdrawn**

At page 9 of the Office Action, the Examiner rejected claims 1-5 under the judicially created doctrine of obviousness type double patenting over claims 1-23 of U.S. Patent No. 6,492,497.

Applicant has canceled claims 1-5, rendering moot any rejections thereof. Applicant respectfully submits that claims 1-23 of U.S. Patent No. 6,492,497 are directed to a separate and distinct invention from the subject matter of new claims 40-63. Accordingly, no issues of obviousness type double patenting arise. Applicant respectfully requests reconsideration and withdrawal of the rejection.

**CONCLUSION**

The Examiner is hereby respectfully invited to contact the undersigned attorney at the number listed below with any questions, comments or suggestions relating to this application.

Respectfully submitted,  
HOWREY LLP

By: /David W. Clough/  
David W. Clough, Ph.D.  
Registration No.: 36,107  
Customer No. 22930

Dated: June 29, 2007

HOWREY LLP  
321 N. Clark Street, Suite 3400  
Chicago, IL 60610  
(312) 595-1239 (main)  
(312) 595-1408 (direct)  
(312) 595-2250 (fax)